

## **REMARKS**

This is a full and timely response to the outstanding non-final Office Action mailed November 18, 2004. Applicants amend 1 – 5, 16-18, 21-23, 25-27, 32, 34-35, and 38, add new claims 39 – 58, and cancel claims 6 – 15, 19, 20, 24, 28 – 31, 33, 36 and 37 without prejudice, waiver, or disclaimer. Applicants cancel these claims merely to reduce the number of disputed issues and to facilitate early allowance and issuance of other claims in the present application. Applicants reserve the right to pursue the subject matter of these canceled claims in a continuing application, if Applicants so choose, and does not intend to dedicate the canceled subject matter to the public. Reconsideration and allowance of the application and presently pending claims are respectfully requested. In addition, Applicants do not intend to make any admissions regarding any other statements in the Office Action that are not explicitly referenced in this response.

### **I. Priority**

The Office Action indicates that Applicants have not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. §120 or §119(e). Applicants should be not presumed to agree with any statements made in the Office Action regarding the priority of the Application unless otherwise specifically indicated by Applicants.

### **II. Objections to the Drawings**

The Office Action indicates that the drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference characters mentioned in the description: 88 (Figure 4); 113 (Figure 5), 206 (Figure 15). In response, Applicants amend FIGS. 4, 5, and 15 to comply with the Office Action's request. More specifically, Applicants

remove reference numeral 88 from FIG. 4; remove reference numeral 113 from FIG. 5, and remove reference numeral 206 from FIG. 15. Applicants submit that no new matter is added.

In addition, the Office Action objects to the drawings “because they do not include reference sign ‘175’ (page 15, Line 20). In response, Applicants add reference numeral 175 to FIG. 12. Applicants submit that no new matter is added.

Finally, the Office Action objects to the drawings under 37 C.F.R. 1.83(a), as not showing every feature of the invention specified in the claims. Applicants cancel claim 11 and amend claim 38. Applicants submit that the claims comport with the Office Action’s request. More specifically, “a first user-selectable index” is highlighted in FIG. 5 (105, 106), and “a second user-selectable index” is highlighted in FIG. 6 (104, 105). For at least this reason, Applicants respectfully request that the objection to the drawings be removed.

### **III. Double Patenting Rejection**

The Office Action indicates that should claim 1 be found allowable, claim 2 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. In response, Applicants amend claim 2 to comport with the Examiner’s request and respectfully request that this rejection be removed.

### **IV. Rejections Under 35 U.S.C. §112**

The Office Action indicates that claims 11, 26 and 38 stand rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. Applicants cancel 11 and amend claims 26 and 38. Applicants submit that these amendments comply with the Office Action’s request.

**V. Rejections Under 35 U.S.C. §102**

A proper rejection of a claim under 35 U.S.C. §102 requires that a single prior art reference disclose each element of the claim. *See, e.g., W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983).

**A. Claims 1 – 5, 17, 21, 22, 25 – 27, 32, 34, 35, and 38 are Patentable Over LaJoie**

**1. Claim 1 is Patentable Over LaJoie**

The Office Action indicates that claim 1 stands rejected under 35 U.S.C. §102(b) as being anticipated by U.S. patent number 5,850,218 to LaJoie (“*LaJoie*”). In response, Applicants amend claim 1 to more fully illustrate patentable features of claim 1 over the cited art. More specifically, claim 1 now recites

A method for providing media information to a user via an interactive media services client device coupled to a programmable media services server device, said method comprising steps of:

receiving media information corresponding to a plurality of accessible media;

configuring a display order of media titles in the received media information according to the value of a media information parameter;

defining each index in a plurality of user-selectable indices according to a respective range of values of the media information parameter, each respective range of values being determined ***according to a first threshold*** defining a predetermined number of media titles;

configuring the plurality of user-selectable indices for indexing the media titles in the display order, each user-selectable index corresponding to the media titles in the received media information determined by the respective range of values of the media information parameter corresponding to the user-selectable index;

responsive to a user selecting a first user-selectable index, providing simultaneously in the display order at least a portion of the

media titles corresponding to the first user-selectable index and the user-selected category.

Applicants respectfully assert that claim 1, as amended is patentable over *LaJoie* for at the reason that *LaJoie* fails to disclose, teach, or suggest a method comprising “defining each index in a plurality of user-selectable indices according to a respective range of values of the media information parameter, each respective range of values being determined *according to a first threshold* defining a predetermined number of media titles...” (Claim 1, as amended). For at least this reason, claim 1 is patentable over *LaJoie*.

## **2. Claim 2 is Patentable Over *LaJoie***

The Office Action indicates that claim 2 stands rejected under 35 U.S.C. §102(b) as being anticipated by U.S. patent number 5,850,218 to LaJoie (“*LaJoie*”). In response, Applicants amend claim 2 to more fully illustrate patentable features of claim 2 over the cited art. More specifically, claim 2 now recites

A method for providing media information to a user via an interactive media services client device coupled to a programmable media services server device, said method comprising steps of:

receiving media information corresponding to a plurality of accessible media;

configuring an interactive media guide with a display order of the media titles in the received media information according to the value of a media information parameter and according to a portion of the received media information corresponding to a user-selected category;

determining a range of values of the media information parameter corresponding to each index in a plurality of user-selectable indices, the range of values being determined *according to the number of media titles in the portion of the received media information corresponding to the respective range of values*;

configuring the interactive media guide with the plurality of user-selectable indices for indexing the media titles in the display order;

presenting to a user an interactive media guide having ~~an~~ a plurality of indexing prompts corresponding to respective user-selectable indices;

receiving a first user input identifying a first indexing prompt corresponding to a first user-selectable index; and

responsive to the first user input, providing simultaneously in the display order at least a portion of the media titles corresponding to the first user-selectable index and the user-selected category.

Applicants respectfully assert that claim 2, as amended is patentable over *LaJoie* for at the reason that *LaJoie* fails to disclose, teach, or suggest a method comprising “determining a range of values of the media information parameter corresponding to each index in a plurality of user-selectable indices, the range of values being determined *according to the number of media titles in the portion of the received media information corresponding to the respective range of values...*” (Claim 2, as amended). For at least this reason, claim 2 is patentable over *LaJoie*.

### 3. Claim 17 is Patentable Over *LaJoie*

The Office Action indicates that claim 17 stands rejected under 35 U.S.C. §102(b) as being anticipated by *LaJoie*. In response, Applicants amend claim 17 to more fully illustrate patentable features of claim 17 over the cited art. More specifically, claim 17 now recites

An interactive media services client device for providing media information to a user comprising:

memory for storing media information received from a server, said media information corresponding to a plurality of respective accessible media; and

a processor configured to cause to:

cause a display order of the media titles in the received media information according to the value of the release year of the media title;

***enable a plurality of user-selectable indices for indexing displayed media titles, each user-selectable index corresponding to a range of at least one year;***

determine the media titles in the received media information corresponding to each user-selectable index and a user-selected category; and

responsive to a user input, provide simultaneously in the display order at least a portion of the media titles in the received media information corresponding to a first user-selectable index and the user-selected category.

Applicants respectfully assert that claim 17, as amended is patentable over *LaJoie* for at the reason that *LaJoie* fails to disclose, teach, or suggest a device with a processor configured to “*enable a plurality of user-selectable indices for indexing displayed media titles, each user-selectable index corresponding to a range of at least one year...*” (Claim 17, as amended). For at least this reason, claim 17, as amended is patentable over *LaJoie*.

**B. Claims 3 – 5, 21, 22, 25 – 27, 32, 34, 35, and 38 are Patentable Over *LaJoie***

In addition, dependent claims 3 – 5 are believed to be allowable for at least the reason that these claims depend from allowable independent claim 1. Further, dependent claims 21, 22, and 25 – 27 are believed to be allowable for at least the reason that they depend from allowable independent claim 17. Finally, dependent claims 32, 34, 35, and 38 are believed to be allowable for at least the reason that they depend from newly added allowable independent claim 52. *Minnesota Mining and Mfg. Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002).

**V. Rejections Under 35 U.S.C. §103**

**A. Applicable Legal Authority**

In order for a claim to be properly rejected under 35 U.S.C. §103, the teachings of the prior art reference must suggest all features of the claimed invention to one of ordinary skill in the art. *See, e.g., In re Dow Chemical*, 837 F.2d 469, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988); *In re Keller*, 642 F.2d 413, 208 U.S.P.Q. 871, 881 (C.C.P.A. 1981). Further, “[t]he PTO has the burden under section 103 to establish a prima facie case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.” *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

**B. Claim 16 is Patentable Over LaJoie**

The Office Action recites that

[t]he examiner takes Official Notice that it is notoriously well known in the art for cable service providers, such as Time Warner Cable (the assignee of the LaJoie et al reference) to charge a fee in connection with subscribing to their services including the ability to access an interactive media guide. Accordingly, it would have been obvious, if not implicit to the reference to one having ordinary skill in the art at the time the invention was made to ‘charge the user a fee in connection with the provision of indexing functionality for the inherent advantages associated with charging subscribers usage fees including but not limited to the ability of the service provider to re-coup costs and profit from providing cable services (OA p. 9, item 13).

Applicants respectfully traverse this rejection, and statement of Official Notice for at least the reason that the noticed fact is not capable of instant and unquestionable demonstration as being well-known.

Claim 16 recites “[t]he method of claim 1, further comprising the step of: charging the user a fee in connection with the provision of indexing functionality.” Applicants assert that the basis for the finding (in addition to the finding itself) does not include specific factual findings predicated

on sound technical and scientific reasoning to the support the conclusion (as required), evidencing it not being well-known. As such, a statement of Official Notice is unwarranted. As recited in MPEP §2144.03(A), “it [is] *not*...appropriate for the Office Action to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known.”

#### **IV. Newly Added Claims**

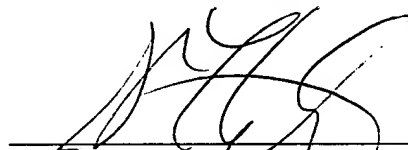
Applicants add new claims 39 – 58. Applicants submit that newly added independent claim 52 is allowable for at least the reason that the cited art fails to suggest, teach, or disclose a device with a processor configured to “determine a range of values of the media information parameter corresponding to each index in a plurality of user-selectable indices, the range of values being determined according to the number of media titles in the portion of the received media information corresponding to the respective range of values...” (claim 52). In addition, Applicants submit that newly added dependent claims 42, 44, and 46 are allowable for at least the reason that they depend from allowable independent claim 1. In addition newly added dependent claims 39, 40, 41, 43, 45, 47, and 48 are allowable for at least the reason that these claims depend from allowable independent claim 2. Further, newly added dependent claims 49 – 51 are believed to be allowable for at least the reason that these claims depend from allowable independent claim 17. Finally, newly added dependent claims 53 – 58 are believed to be allowable for at least the reason that these claims depend from newly added allowable independent claim 52. *Minnesota Mining and Mfg. Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002).



## CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, Applicants respectfully submits that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims 1 – 5, 16-18, 21-23, 25-27, 32, 34-35, and 38, newly added claims 39 – 58 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'JK', is written over a horizontal line.

Jeffrey R. Kuester; Reg. No. 34,367

**THOMAS, KAYDEN,  
HORSTEMEYER & RISLEY, L.L.P.**  
Suite 1750  
100 Galleria Parkway N.W.  
Atlanta, Georgia 30339  
(770) 933-9500